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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/964,034	09/26/2001	John A. M. Cameron	WEAT/0151	9883

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EXAMINER

HALFORD, BRIAN D

ART UNIT PAPER NUMBER

3672

DATE MAILED: 12/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/964,034

Applicant(s)

CAMERON, JOHN A. M.

Examiner

Brian D Halford

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13, 15-29 and 31-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 31 and 32 is/are allowed.
- 6) ☒ Claim(s) 1-3, 10, 19-29 and 33-36 is/are rejected.
- 7) ☒ Claim(s) 4-9, 11-13 and 15-18 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3,5,6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-3, 19, 22-23, 29, 33 and 35-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Lembcke *et al.* As stated in the abstract, Lembcke *et al.* disclose a packer that envelopes a control line as it expands against a casing tubular or wellbore. The merits of the invention are discussed in lines 25-67 and 1-33 of respective columns 2 and 3. As illustrated in Figures 1 and 2, the packer *or* expandable tubular (P) possesses an arcuate groove *or* recess (14) in its outer wall. The groove *or* recess (14) serves as a housing for a control line (16). As disclosed in lines 12-19 of column 1, the control line is defined to encompass a cable of any type, including fiber optic and conductor lines. The control line (16) is completely enveloped by the packer *or* expandable tubular (P) during the expansion process thereby ensuring a leak-proof seal. As depicted in the aforementioned drawing figures, the groove *or* recess (14) forms an arcuate wall.

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Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 10, 20-21, 24-28 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lembcke *et al.* in view of Evans *et al.* The patent to Lembcke *et al.* has been discussed *supra*. However, Lembcke *et al.* fail to disclose an encapsulation within the groove *or* recess (14) that possesses a first and second walls, wherein at least one of the walls is arcuate. The patent to Evans *et al.* disclose an encapsulation for two control lines and the like in columns 1-4; furthermore, the invention is depicted in Figures 1 and 2. As discussed in lines 45-61 and 7-14 of respective columns 1 and 2, an encapsulation for control lines fabricated from elastomeric material is disclosed that is capable of withstanding excessive radial expansion forces. As such, the control lines enveloped by the elastomeric material remain intact while the encapsulation is subject to excessive radial expansion forces. As mentioned in lines 3-8, 30 and 34-68 of column 3, the encapsulation, generally designated by the letter, "A" contains a crescent-shaped sheath or housing (14) of elastomeric material and two metal tubulars (12, 13) that serve as fluid control lines. The geometry of the encapsulation is such that it possesses first arcuate wall and a second wall, which are connected to form a housing. Evans *et al.* outline additional advantages of the invention in lines 47-59 of column 4.

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Turning back to the Lembcke *et al.* reference, it is noted by the Examiner that Lembcke *et al.* disclose in line 54 of column 1 that control lines are jeopardized by the infiltration of fluids. As such, Lembcke *et al.* are concerned, in part, with creating a leak-proof seal. Lembcke *et al.* accomplish the goal by creating a tight seal around the control line (16) during the expansion of the packing element (12). Furthermore, lines 29-33 of column 3 permits modifications to the size, shape and materials of the packer *or* expandable tubular (P). Thus, the groove *or* recess (14) can be modified to entertain the addition of the encapsulation of Evans *et al.* Therefore, it would have been obvious to a person of ordinary skill in the art, at the time the invention was made, to modify the packer *or* expandable tubular of Lembcke *et al.* to accommodate the encapsulation of Evans *et al.* to protect against fluid infiltration during packer failure in addition to avoiding control line failure as a result of unexpected excessive radial forces during tubular expansion.

Allowable Subject Matter

5. Claims 31-32 are allowed.
6. Claims 4-9, 11-13 and 15-18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Response to Arguments

7. Applicant's arguments, see pages 10-12, filed 28 April 2003, with respect to the rejection(s) of claim(s) 1-3, 7, 19, 22-23, 27 and 29-30 under *Castano-Mears et al.* and claims 8, 10-13, 15-18, 20-21, 24-26 and 28 under *Castano-Mears et al.* in view of *Ramos et al.* have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection, as discussed *supra*, is made in view of *Lembcke et al.*

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian D Halford whose telephone number is (703) 306-0556. The examiner can normally be reached on M-F 10:30-8:00; alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J Bagnell can be reached on (703) 308-2151. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.



David Bagnell
Supervisory Patent Examiner
Art Unit 3672

bdh
December 03, 2003